

THOMPSON COBURN

Thompson Coburn LLP
Attorneys at Law

One US Bank Plaza

St. Louis, Missouri 63101-1693

314-552-6000

FAX 314-552-7000

www.thompsoncoburn.com

Facsimile

FOR IMMEDIATE DELIVERY

To	Firm Name	Phone	Fax
Commissioner for Patents	United States Patent and Trademark Office; Office of Petitions		703-308-6916

From: Daniel S. Kasten

Date: 11/04/2003

Message: Application of: Wold et al.
 Serial No: 09/111,911
 Filed: July 8, 1998
 Title: Inhibiting Apoptosis with Adenovirus RID Protein
 Examiner: Ram R. Shukla, Ph.D.
 Group Art Unit: 1632

Petition to Commissioner under 37 CFR 1.181

RECEIVED

NOV 07 2003

TECH CENTER 1600/2900

FAX RECEIVED

NOV 04 2003

PETITIONS OFFICE

Atty/Client/Matter No.: 3067/66153/05587

Total Number of Pages, including this page: 51

If you do not receive all of the pages, please call 314-552-6305 as soon as possible.

Thank you,

Fax Department - Operator: DM Time of Transmittal: 7:15 A.M./P.M.**Confidentiality Note**

The information contained in this facsimile transmission is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this transmission is not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this transmission is strictly prohibited. If you have received this transmission in error, please immediately notify us by collect telephone call and return the original transmission to us at the above address by U.S. mail. Thank you.

PTO/SB/17 (11-00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL
for FY 2001**

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT

(\$130)

Complete if Known

Application Number	09/111,911
Filing Date	July 8, 1998
First Named Inventor	Wold, William S.M.
Examiner Name	Ram R. Shukla, Ph.D.
Group Art Unit	1632
Attorney Docket No.	66153-5587

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number
Deposit
Account
Name

20-0823

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17.
☒ Applicant claims small entity status. See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION**1. BASIC FILING FEE**

Large Fee Code	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee
106	330	206	165	Design filing fee
107	510	207	255	Plant filing fee
108	740	208	370	Reissue filing fee
114	160	214	60	Provisional filing fee
SUBTOTAL (1) (\$)				

2. EXTRA CLAIM FEES

Large Fee Code	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2) (\$)				

*For number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

FAX RECEIVED

NOV 04 2003

Large Fee Code	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or sheet
127	50	227	25	Surcharge - late provisional filing fee or cover sheet
139	130	139	130	Non-English specification
147	2,520	147	2,520	For filing a request for ex parte reexamination
112	920*	112	920*	Requesting publication of SIR prior to Examiner action
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action
115	110	215	55	Extension for reply within first month
116	400	216	200	Extension for reply within second month
117	920	217	480	Extension for reply within third month
118	1,440	218	720	Extension for reply within fourth month
128	1,960	228	980	Extension for reply within fifth month
119	320	219	160	Notice of Appeal
120	320	220	160	Filing a brief in support of an appeal
121	260	221	140	Request for oral hearing
138	1,510	138	1,510	Petition to institute a public use proceeding
140	110	240	55	Petition to revive - unavoidable
141	1,280	241	640	Petition to revive - unintentional
142	1,280	242	640	Utility issue fee (or reissue)
143	460	243	230	Design issue fee
144	620	244	310	Plant issue fee
122	130	122	130	Petitions to the Commissioner
123	50	123	50	Processing fee under 37 CFR 1.17(q)
126	180	126	180	Submission of Information Disclosure Sheet
581	40	581	40	Recording each patent assignment per property (times number of properties)
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(e))
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))
179	740	279	370	Request for Continued Examination (RCE)
169	900	169	900	Request for expedited examination of a design application
Other fee (specify)				
SUBTOTAL (3) (\$)				130

*Reduced by Basic Filing Fee Paid

SUBMITTED BY

Name (Print/Type)

Daniel S. Kasten

Registration No.
(Attorney/Agent)

45,363

Complete (if applicable)

Telephone

314-552-6305

Signature

Date

November 4, 2003

WARNING: Information on this form may become public. Credit Card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

PTO/SB/17 (11-00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL
for FY 2001**

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$)130**Complete if Known**

Application Number	09/111,911
Filing Date	July 8, 1998
First Named Inventor	Wold, William S.M.
Examiner Name	Ram R. Shukla, Ph.D.
Group Art Unit	1632
Attorney Docket No.	66153-5587

METHOD OF PAYMENT

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number

20-0823

Deposit
Account
Name

- ☒
- Charge Any Additional Fee Required
-
- Under 37 CFR 1.16 and 1.17.
-
- ☒
- Applicant claims small entity status.
-
- See 37 CFR 1.27

- 2.
- ☐
- Payment Enclosed:

☐ Check ☐ Credit Card ☐ Money
Order ☐ Other
FEE CALCULATION**1. BASIC FILING FEE**

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	180	214	80	Provisional filing fee	

SUBTOTAL (1) (\$)**2. EXTRA CLAIM FEES**

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent	-20** =	X	=
Multiple Dependent	-3** =	X	=

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	130
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130**SUBMITTED BY**

Name (Print/Type) Daniel S. Kasten

Registration No.
(Attorney/Agent)

45,363

Complete (if applicable)

Telephone

314-552-6305

Signature

Daniel S. Kasten

Date

November 4, 2003

WARNING: Information on this form may become public. Credit Card Information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

RECEIVED
NOV 07 2003
TECH CENTER 1600/2900**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing document and all referenced attachments were transmitted via facsimile to the Office of Petitions at the U.S. Patent and Trademark Office, facsimile number 703-308-6916, on November 4, 2003.



Daniel S. Kasten
Registration No. 45,363

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Wold, William S.M.	Group No.:	1632
Serial No.:	09/111,911	Atty. Docket No.:	66153-5587
Filed:	July 8, 1998		
For:	INHIBITING APOPTOSIS WITH ADENOVIRUS RID PROTEIN	Examiner:	Ram R. Shukla, Ph.D.

Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FAX RECEIVED
NOV 04 2003
PETITIONS OFFICE

PETITION UNDER 37 C.F.R. § 1.181

Applicant hereby petitions the commissioner, under 37 C.F.R. §1.181 for reconsideration of the Examiner's decision not to enter Applicant's amendment (dated October 4, 2002) and response after advisory action. Applicant requests that the amendment be entered and the claims be allowed. The facts are as follows:

In a final Office Action dated June 17, 2002 (copy enclosed), the Examiner indicated that of the pending claims (1, 4, 7, 10, 13 and 23-26), claims 1, 4, and 23-26 are allowed; claims 7, 10 and 13 are rejected; and claim 26 is objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant filed a response to the final Office Action on August 14, 2003 (copy enclosed), in which claim 7 was canceled, and new claims 27 and 28 were added. Arguments were submitted in support of the pending claims.

The Examiner issued an Advisory Action on September 13, 2002 indicating that Applicant's amendment of August 14, 2002 had not been entered and again indicating that claims 1, 4, 7, 10, 13 and 23-26 are pending; claims 1, 4 and 23-25 are allowed; claim 26 is objected to; and claims 7, 10 and 13 are rejected.

Applicant then filed, on October 4, 2002, an amendment (copy enclosed) in which claims 7, 10 and 13 are canceled; and claim 26 is amended to be in independent form, incorporating all of the limitations of the base claim and all intervening claims, as required. That response was received by the USPTO, as indicated in the enclosed Auto-Reply Facsimile Transmission. However, for reasons unclear to Applicant, the response was not married up to the file once received by the USPTO. Applicant subsequently re-submitted the response on April 3, 2003, and again on June 3, 2003, at which point it finally was matched up with the file, and forwarded to the Examiner.

The Examiner then issued a second Advisory Action, dated September 4, 2003, indicating that the amendment filed on October 4, 2002 was not entered, and again indicating that claims 1, 4, 7, 10, 13 and 23-26 are pending; claims 1, 4 and 23-25 are allowed; claim 26 is objected to; and claims 7, 10 and 13 are rejected. The Examiner asserts that the Response of October 4, 2002 does not address the enablement rejection relative to claim 26, as amended. Applicant points out that claim 26 was never rejected on the grounds of enablement, and as indicated in the final Office Action, and subsequent Advisory Actions, is allowable if amended to be in independent form.

The Examiner further asserts that Applicant does not address the status of claims 27 and 28 in the Response of October 4, 2002. Here, Applicant points out that those claims were added by an amendment, filed August 14, 2002, that was not entered. Thus, those claims were never pending. Further, the Advisory Actions of 9/13/02 and 9/4/03 indicate that claims 27 and 28 are NOT pending.

The Examiner further asserts that Applicant did not provide any new arguments as to how the proposed amendment to claim 26 addressed the enablement rejection set for in the previous Office Actions. Again, Applicant points out that claim 26 was NOT subject to an enablement rejection, and thus argument to overcome that rejection is not necessary. As previously discussed, the Examiner had previously indicated that claim 26 is allowable, if rewritten in independent form, incorporating all of the limitations of the base claim and intervening claims. Applicant has done so.

In summary, Applicant hereby asserts that all of the outstanding issues are obviated by Applicant's response filed October 4, 2002, and thus the Examiner has improperly refused to enter that amendment and allow the case to proceed to issuance. According to 37 C.F.R. §1.116(b), "After a final rejection or other final action (§1.113) in an application..., amendments

may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action." Here, Applicant's Response of October 4, 2002 merely cancels rejected claims, and amends claim 26 in compliance with the requirement expressly set forth in the Final Office Action of June 17, 2002. Thus, the Response complies with 37 C.F.R. §1.116, and therefore the Examiner improperly refused entry. Claims 27 and 28 were never entered, and thus need not be addressed. However, to the extent necessary, Applicant hereby authorizes and directs the Office to withdraw and/or cancel claims 27 and 28. Since the only claims remaining after entry of the amendment of October 4, 2002 are, as indicated by the Examiner, allowable, Applicant hereby requests that the Examiner's refusal to enter the Response of October 4, 2002 be withdrawn, that the Response of October 4, 2002 be entered, and that the case proceed to allowance.

Respectfully submitted,



Daniel S. Kasten, Reg. #45363
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6305
Fax: 314-552-7305



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20531
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/111,911	07/08/1998	WILLIAM S. M. WOLD	16153-5587	6287

21888 7590 06/17/2002

THOMPSON COBURN, LLP
ONE FIRSTAR PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

SHUKLA, RAM R

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 06/17/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

NOV 07 2003

TECH CENTER 1600/2900

FAX RECEIVED

NOV 04 2003

PETITIONS OFFICE

RECEIVED

JUN 24 2002

Thompson Coburn LLP

Advisory due 8/19/02

Appeal due

RECEIVED / TC

date: 9/19/02, 12/19/02
due 6/24/02 for

Check:

Office Action Summary	Application No. 09/111,911	Applicant(s) WOLD, WILLIAM S. M.	
	Examiner Ram Shukla	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,10,13 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4 and 23-25 is/are allowed.
- 6) ☒ Claim(s) 7,10 and 13 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

FAX RECEIVED

NOV 04 2003

PETITIONS OFFICE

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *detailed action*

RECEIVED
NOV 07 2003
TECH CENTER 1600/2900

RECEIVED

NOV 07 2003

Page 2

Application/Control Number: 09/111,911

Art Unit: 1632

TECH CENTER 1600/2900

DETAILED ACTION

1. The request filed on 4-2-02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/111,911 is acceptable and a CPA has been established. An action on the CPA follows. It is noted that the applicants had filed an RCE under 37 CFR 1.114, however, the request was treated as a request for CPA as noted in the communication of 5-28-02, since the parent application was filed prior to 29 May 2000 and this was the first instance of continuation application filing.

2. Amendment/response filed 4-2-02 is acknowledged.

3. Claim 14 has been cancelled.

4. New claims 26 has been entered.

5. Amendments to claims 4, 7, 10 and 13 have been entered.

4. Claims 1, 4, 7, 10, 13 and 23-26 are pending.

FAX RECEIVED

NOV 04 2003

PETITIONS OFFICE

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 10, 13 remain rejected and the amended claim 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an in vitro method of inhibiting apoptosis of a cell, wherein the cell expresses Fas, TNFR-1, DR-3, TRAIL-R1, or TRAIL-2, comprising, contacting the cell with an adenovirus comprising a CMV promoter operably linked to a polynucleotide that encodes a RIDa polypeptide, a RIDa-L, and a RIDp, disclosed in SEQ ID NO:1, SEQ ID NO: 2, and SEQ ID NO:4, wherein the adenovirus enters the cell, the RIDa polypeptide, a RIDcc-L, and a RIDp are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, the adenovirus lacks at least one functional E1 gene, the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, and the apoptosis is mediated

Application/Control Number: 09/111,911

Page 3

Art Unit: 1632

by Fas receptor activity, does not reasonably provide enablement for other embodiments for reasons of record set forth in the previous office action of 10-15-01 and 1-2-02.

It is noted that applicants have not presented any new arguments regarding the grounds of rejection set forth in the previous office action of 10-15-01 and 1-2-02. They have rather asserted that the claim 10 as amended does not rely on the fact that the murine model presented in example 9 is an art recognized model. Applicants further argue that example 9 describes transplantation of heterologous cells into an immunocompetent animal which were able to grow in the animal. While the claim 10 as amended recites a method of decreasing the rejection of transplanted cells compared to previously recited method of decreasing the rejection of cells in a patient, the amendment does not obviate the rejection set forth in the previous office actions of 1-2-02 since the method is interpreted as a method of treatment wherein cells are transplanted in a patient, the rejection of the cells is decreased, and the cells treat the disease such as degenerative disease or an immunodeficiency disease. As noted in the previous office action of 10-15-01, the specification is not enabling for the claimed invention because the mouse model disclosed in the specification is not an art recognized model of cell or tissue transplantation and rejection. Regarding claim 7, it is noted that as amended it depends from claim 4 which in turn depends from claim 1. While claim 1 is enabled, claim 7 is not enabled since its utility as recited in the claim is for transplantation in a patient, which is not enabled as discussed.

8. Claims 1, 4 and 23-25 are free of the prior art of record.
9. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

Application/Control Number: 09/111,911

Page 4

Art Unit: 1632

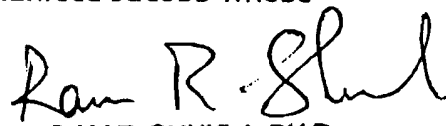
MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

If the claims are amended, added and/or canceled in response to this office action the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and a clean copy of all pending claims is requested.

Any Inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for this Group is (703) 308-4242. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the Dianiece Jacobs whose telephone number is (703) 305-3388.

Ram R. Shukla, Ph.D.


RAM R. SHUKLA, PH.D.
PATENT EXAMINER

ASSISTANT COMMISSIONER FOR PATENTS,
KINDLY ACKNOWLEDGE RECEIPT BY DATE STAMPING AND RETURNING.

Applicant(s): Wold, William S.M. (Saint Louis University) PCTUS #: 09/111,911
Title: Inhibiting Adenovirus with B7-1 Protein Filed: July 8, 1998
Att/Client/Matter No.: 106153/5587
☒ Transmittal Letter(s) (duplicate)
☐ Specification: _____ Pages
☐ Number of Claims: _____ Pages
☐ Abstract: _____ Pages
☐ Drawings: _____ Sheet(s) _____ Formal _____ Informal
☐ Declaration/POA _____ signed _____ unsigned
☐ Assignment
☒ Amendment/Response
☐ Petition under 37 CFR 1.136(a)
☐ CPA Transmittal
☐ Information Disclosure Statement w/Ref.
☐ Issue Fee Payment
☐ Request
☐ Demand
☐ Fee Calculation Sheet
☐ Notice of Appeal ☐ Appeal Brief
☐ Statement Under 3.73 (b)
☐ Other
☐ Small Entity Declaration
☐ Fee of \$ _____ Paid by
☐ Deposit Acct. No. 20-0823
☐ Check No. _____
Date Mailed: August 14, 2002
Express Mail No.: _____



Rev. 2/02

DOCKETED

AUG 15 2002

Thompson Coburn LLP

PTO/SB/05 (03-01)

Please type a plus sign (+) inside this  Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Attorney Docket No.		66153-5587	First Inventor: Wold, William S.M.
AMENDMENT TRANSMITTAL LETTER Title: Inhibiting Apoptosis with Adenovirus RID Protein		Serial No.	09/111,911
		Filing Date	July 8, 1998
		Examiner	Ram R. Shukla
		Group Art Unit	1632

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is an amendment in the above-identified application.

☒ Large Entity Status☐ Small Entity status of this application has been established under 37 CFR 1.27

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED - PART II						SMALL ENTITY		OTHER THAN SMALL ENTITY	
AMENDMENT	(Column 1)		(Column 2)	(Column 3)	RATE	ADDITIONAL FEE	RATE	ADDITIONAL FEE	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA					
	Total (37 CFR 1.16(e))	*10	Minus	**25	0	x \$9.00=	0.00	x \$_____ =	0.00
	Independent (37 CFR 1.16(b))	*4	Minus	***5	0	x \$42.00=	0.00	x \$_____ =	0.00
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))					x \$0=		+ \$_____ =		
					TOTAL ADDIT. FEE	0.00	TOTAL ADDIT. FEE	0.00	


* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
 ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
 The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

☐ Petition of Extension of Time.☒ No additional fee is required for amendment.☐ A check in the amount of the fee is enclosed.☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. 20-0823.☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 20-0823.
I have enclosed a duplicate copy of this sheet.☒ Any additional filing fees required under 37 C.F.R. 1.16.☒ Any patent application processing fees under 37 C.F.R. 1.17.

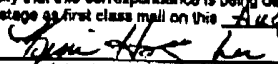
DOCKETED

AUG 16 2002

Thompson Coburn LLP

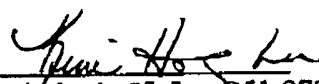

 Kimberly H. Lu, Reg. No. P51,973
 Thompson Coburn LLP
 One US Bank Plaza, Suite 3500
 St. Louis, MO 63101-9928
 314-552-6307
 314-552-7307 FAX
 Custom No.: 021888
 1722480

Date: August 14, 2002

Certificate of Mailing	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail on this <u>August 14, 2002</u> day of <u>August</u> .	
Signature:	
Type Name:	<u>Kimberly H. Lu</u>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**CERTIFICATE OF MAILING UNDER 37 CFR §1.8**

I hereby certify that this correspondence and documents referred to as enclosed therein are being deposited with the United States Postal Service with sufficient postage as first class mail on this 14th day of August, 2002 in an envelope addressed to: BOX NONFEE AMENDMENT, Assistant Commissioner for Patents, Washington, D.C. 20231.


Kimberly H. Lu, P51,973

Application of:	Wold, William S. M.	Group No.:	1632
Serial No.:	09/111,911	Atty. Docket No.:	66153-5587
Filed:	July 8, 1998		
For:	Inhibiting Apoptosis with Adenovirus RID Protein	Examiner:	Shukla, Ram R.

Commissioner of Patents and Trademarks
Washington, DC 20231

AMENDMENT AND RESPONSE

HONORABLE SIR:

Applicant submits this paper in response to the Office Action, paper no. 19, mailed on June 17, 2002, and in accordance with Rule 1.111 of the Rules of Practice. Applicants respectfully requests reconsideration and entry of the following amendments and remarks intended to put the above-identified application into form for allowance.

Application Serial No. 09/111,911

IN THE CLAIMS:

Please cancel claim 7.

Claims 10 and 26 have been amended as indicated in a marked-up version of the claims attached hereto:

10. (Five times amended) A method for inhibiting apoptosis in a cell comprising contacting the cell with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, and (e) the adenovirus lacks at least one functional E1 gene and, wherein said cell is introduced into a host.

26. (Amended) The method of claim 13 wherein the host is a mouse.

Please add the following new claims:

27. (New) The method of claim 10, wherein the cell is a human cell.

28. (New) The method of claim 27, wherein the cell is an A549 cell.

REMARKS

Claims 1, 4, 7, 10, 13, and 23-26 are pending in the instant application. Claims 10 and 26 have been amended. Claims 27 and 28 have been added. Claim 7 has been cancelled.

Application Serial No. 09/111,911

Claims 1, 4, and 23-25 are allowed. Claim 26 is objected to. Claims 7, 10, and 13 stand rejected under 35 U.S.C. § 112, first paragraph, for an alleged failure to provide an enabling description. Specifically, the Examiner alleges that:

[T]he specification, while being enabling for an in vitro method of inhibiting apoptosis of a cell, ...does not reasonably provide enablement for other embodiments for the reasons of record....

While the claim 10 as amended recites a method of decreasing the rejection of transplanted cells compared to previously recited method of decreasing the rejection of cells in a patient, the amendment does not obviate the rejection set forth in the previous office action of 1-2-02 since the method is interpreted as a method of treatment wherein cells are transplanted in a patient, the rejection of the cells is decreased, and the cells treat the disease such as degenerative disease or an immunodeficiency disease....[T]he specification is not enabling for the claimed invention because the mouse model disclosed in the specification is not an art recognized model of cell or tissue transplantation and rejection.

Claim 7 has been cancelled. Although Applicant believes that the specification fully enables a method of decreasing rejection of transplanted cells, solely to advance the prosecution of the instant application, Applicant has amended claim 10 to recite a method of inhibiting apoptosis, which is consistent with the allowed claims. Applicant has also added claims 27 and 28. Support can be found in Examples 7-9. Specifically, cells introduced into an immunocompetent host are usually destroyed by immune killer cells of the host. Examples 7 and 8 show that the RID complex can inhibit apoptosis. Example 9 describes introduction of the 231-10 vector (described on p. 5, lines 25-29 and p. 28, lines 5-11 as having the RID complex) into a human cancer cell line, such as A549. The cell is then introduced into a murine host. While a small mass grew in the mouse that received uninfected A549, large tumors grew in the mice that received A549 infected with 231-10. Thus, the specification teaches, among other things, working examples of a method of inhibiting apoptosis in a cell, such as a human cancer cell, which is introduced into a host, such as a mouse.

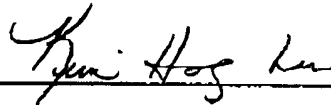
Application Serial No. 09/111,911

Applicant submits that the claims are fully enabled and respectfully requests that the Examiner reconsider and withdraw his rejection under 35 U.S.C. § 112, first paragraph.

CONCLUSION

Applicant believes that he has overcome or obviated all of the Examiner's rejections. Applicant submits that the pending claims are in proper form for allowance and respectfully request that such allowance be granted.

Respectfully submitted,



Kimberly H. Lu, Reg. No. P51,973
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6307
Fax: 314-552-7307

MARKED-UP VERSION OF AMENDED CLAIMS

10. (Five times amended) A method for [decreasing the rejection of transplanted cells] inhibiting apoptosis in a cell comprising contacting the [cells ex vivo] cell with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, and (e) the adenovirus lacks at least one functional E1 gene and [(f) the rejection is mediated by Fas receptor activity] , wherein said cell is introduced into a host.

26. (Amended) The method of claim 13 wherein the [transplanted cells are in] host is a mouse.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/111,911	07/08/1998	WILLIAM S. M. WOLD	16153-5587	6287

21888 7590 09/13/2002

THOMPSON COBURN, LLP
ONE FIRSTAR PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

SHUKLA, RAM R

ART UNIT PAPER NUMBER

1632

DATE MAILED: 09/13/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

SEP 18 2002

Thompson Coburn LLP

RECEIVED

SEP 18 2002

Thompson Coburn LL?

Advisory Action

Application No.

09/111,911

Applicant(s)

WOLD, WILLIAM S. M.

Examiner

Ram R. Shukla

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 8-21-02 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 4 and 23-25.Claim(s) objected to: 26.Claim(s) rejected: 7, 10 and 13.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
 10. ☐ Other: _____

RECEIVED

SEP 18 2002

Thompson Coburn LLP

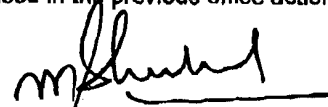
RAM R. SHUKLA, PH.D.
PATENT EXAMINERRam R. Shukla
Examiner
Art Unit: 1632**DOCKETED**

SEP 18 2002

009/111,911

Continuation of 2. NOTE: It is noted that only one claim is cancelled, while two claims have been added. Further, newly presented claim 28 recites a particular cell type, A549 cell, that would require new considerations of search and analysis. Amendments to claims 10 and 26 do not reduce the issues for appeal because they do not address the grounds of enablement rejection set forth in the previous office action. It is noted that the amendment to claim 10 only rewords the claimed invention and still reads on ex vivo therapy and as noted in the previous office actions (10-15-01, 1-2-02 and 6-17-02), claimed invention is only enabled for an in vitro method of inhibiting apoptosis, not for transplantation or therapy. Therefore, amendments do not reduce the issues for appeal. Additionally, in view of the amendment to claim 10 and 26, the issues for analysis of claim 28 will also change.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments have been fully considered, however, applicants' arguments are not persuasive and the rejection of claims 7, 10 and 13 is maintained for reasons of record set forth in the previous office actions of 10-15-01, 1-2-02 and 6-17-02. It is noted that applicants have only listed parts of the specification that they argue supports the claimed invention. Applicants have not provided any new arguments or evidence to support their assertion that the claimed invention was enabled or to address the issues of enablements raised in the previous office actions of 10-15-01, 1-2-02 and 6-17-02.


RAM R. SHUKLA, PH.D
PATENT EXAMINER

18/04/02 16:32:14

USPTO->

Thompson Coburn RightFAX

Page 001

TO:Auto-reply fax to 3145527000 COMPANY:

Auto-Reply Facsimile Transmission



UNITED STATES
PATENT AND
TRADEMARK OFFICE
★★★★

TO:

Fax Sender at 3145527000

Fax Information

Date Received:

Total Pages:

10/4/02 4:28:32 PM (Eastern Daylight Time)

10 (Including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMPEP) section 306 et seq.

Received
Cover
Page
=====>

OCT 04 2002 15:19 FR THOMPSON COBURN LLP 5 3145527000 TO 3067#66153#05587 P.01/10

THOMPSON COBURN

Thompson Coburn LLP
ATTN: Fax at 100
One Metropolitan Center
St. Louis, Missouri 63101-1691
314-552-6000
FAX 314-552-7000
www.thompsoncoburn.com

**Facsimile
FOR IMMEDIATE DELIVERY**

To	From Name	Phone	Fax
Executive East 1000	USPTO Patent Act 1000		700-472-9207

From: DANIEL KARTEN
Date: October 4, 2002
Message:

Attachment(s): 1000 1000 1000 1000

Total Number of Pages, including this page: 10

If you do not receive all of the pages, please call 314-552-6000 as soon as possible.

Thank you.
Fax Transmitted at 10:00:00 PM Total of Transmitted: 312 p. 10/4/02.

Confidentiality Note
The information contained in this document is confidential information and is intended only for the use of the individual or entity named above. If the reader of this document is not the named addressee, you are hereby notified that any dissemination, distribution, or review of this information is strictly prohibited. If you have received this communication in error, please immediately notify us by return telephone call and delete the original communication from your system. Thank you.

Received from <3145527000> at 10/04/02 4:28:32 PM (Eastern Daylight Time)

DOCKETED
DEC 04 2002

Thompson Coburn LLP

02/04/02 14:00

** TX STATUS REPORT **

AS OF OCT 04 2002 15:20 PAGE.01

THOMPSON COBURN LLP 3

DATE TIME TO/FROM MODE MIN/SEC PGS JOB# STATUS
15 10/04 15:19 USPTO EC-S 01'46" 010 148 OK

THOMPSON COBURN

Thompson Coburn LLP
Attorneys at Law

One Mercantile Center

St. Louis, Missouri 63101-1694

314-552-6000

FAX 314-552-7000

www.thompsoncoburn.com

Facsimile FOR IMMEDIATE DELIVERY

To	Firm Name	Phone	Fax
Examiner Ram Shukla	US PTO Group Art Unit 1632		703-872-9307

From: DANIEL KASTEN

Date: October 4, 2002

Message:

Atty/Client/Matter No: 3067/66153/05587

Total Number of Pages, including this page: 10

If you do not receive all of the pages, please call 314-552-6000 as soon as possible.

Thank you,

Fax Department - Operator:

Time of Transmittal: 3:12 A.M./P.M.

DOCKETED

DEC 04 2002

Thompson Coburn LLP

Confidentiality Note

The information contained in this facsimile transmission is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this transmission is not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this transmission is strictly prohibited. If you have received this transmission in error, please immediately notify us by return telephone call and return the original transmission to us at the above address by U.S. mail. Thank you.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

St. Louis, Missouri
October 4, 2002

CERTIFICATE OF FACSIMILE

I hereby certify that this document is being transmitted to the
U.S. Patent and Trademark Office via facsimile to fax no.
(703) 872-9307 on October 4, 2002.

Daniel S. Kasten
Attorney for Applicant(s)
Registration No.: 45,363

Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305

**In re application of:
Wold, William S.M.**

Serial No.: 09/111,911

Filed: July 8, 1998

For: Inhibiting Apoptosis with Adenovirs RID Protein

Examiner Ram R. Shukla, Ph.D.

Group Art Unit 1632

PETITION FOR EXTENSION OF TIME

Sir:

Applicant hereby petitions the Patent Office for a 1 month extension of time to and including October 17, 2002 to respond to the Official Action in the above-identified application. Small entity status is asserted. Please charge the small entity fee of \$110.00 to Deposit Account 20-0823. A duplicate copy of this Petition is enclosed for that purpose.

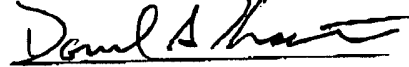
DOCKETED

DEC 04 2002

Thompson Coburn LLP

It is believed that the fee is correct, but the Patent Office is hereby authorized to charge any deficiencies or credit any overpayment to deposit Account 20-0823.

Respectfully submitted,



Daniel S. Kasten

Reg. No. 45363

Thompson Coburn LLP

#1 US Bank Plaza

St. Louis, MO 63101

314-552-6305


October 4, 2002


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

St. Louis, Missouri
October 4, 2002

CERTIFICATE OF FACSIMILE

I hereby certify that this document is being transmitted to the
U.S. Patent and Trademark Office via facsimile to fax no.
(703) 872-9307 on October 4, 2002.


Daniel S. Kasten
Attorney for Applicant(s)
Registration No.: 45,363


Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Wold, William S.M.	Group No.:	1632
Serial No.:	09/111,911	Atty. Docket No.:	66153-5587
Filed:	July 8, 1998		
For:	Inhibiting Apoptosis with Adenovirus RID Protein	Examiner:	Ram R. Shukla, Ph.D.

Commissioner of Patents and Trademarks
Washington, DC 20231

AMENDMENT AND RESPONSE

HONORABLE SIR:

Responsive to the official communication of September 13, 2002, Applicant submits the following Amendments and Remarks.

It is not believed that extensions of time are required beyond those, which may otherwise be provided for in documents accompanying this Amendment. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account 20-0823.

Please amend the above-identified application as set forth below.

In The Claims:

Cancel claims 7, 10 and 13.

26. (Amended) [The method of claim 13] A method for decreasing the rejection of transplanted cells comprising contacting the cells ex vivo with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, (e) the adenovirus lacks at least one functional E1 gene and (f) the rejection is mediated by Fas receptor activity; wherein the

DOCKETED

DEC 04 2002

Thompson Coburn LLP

recombinant adenovirus vector consists of a polynucleotide having a sequence set forth
in SEQ ID NO:5; and wherein the transplanted cells are in a mouse.

REMARKS

Amendments to the Claims

Claims 7, 10 and 13 have been cancelled. Claim 26 has been rewritten in independent form, and now includes the limitations of base claim 10 and intervening claim 13.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



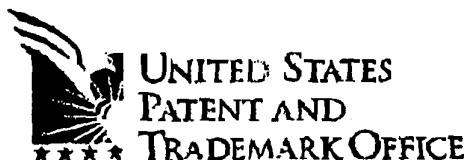
Daniel S. Kastan, Reg. #45363
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6305
Fax: 314-552-7305

Clean Copy of Claim 26

26. (Amended) A method for decreasing the rejection of transplanted cells comprising contacting the cells ex vivo with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, (e) the adenovirus lacks at least one functional E1 gene and (f) the rejection is mediated by Fas receptor activity; wherein the recombinant adenovirus vector consists of a polynucleotide having a sequence set forth in SEQ ID NO:5; and wherein the transplanted cells are in a mouse.

TO:Auto-reply fax to 3145527000 COMPANY:

Auto-Reply Facsimile Transmission



TO:

Fax Sender at 3145527000

Fax Information

Date Received:


Total Pages:

4/3/03 11:54:05 AM [Eastern Standard Time]

12 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page
=====>

PPR 03 2003 10:57 FR THOMPSON COBURN		3145527000 TO 3067#66153#05587 P.31/51	
THOMPSON COBURN		Thompson Coburn LLP Attorneys at Law One Mercantile Center St. Louis, Missouri 63101-1697 314-552-6000 FAX 314-552-7000 www.thompsoncoburn.com	
Facsimile FOR IMMEDIATE DELIVERY			
TO	Firm Name	Phone	Fax
Examiner Ram Duda	US PTO Group Art Unit 1632		703-872-0307
FROM: DANIEL EASTEN			
DATE: APRIL 3, 2003			
MESSAGE: APPLICATION OF: WOLD Serial No. 09/111,011 FILED: JULY 8, 1998 TITLE: INVENTIONS ADAPTED WITH ADVERSELY AID PROTEIN EXAMINER: RAM R. DUDA, Ph.D. GROUP ART UNIT 1632			
App/Cls/Matter No.: 3067/66153/05587			
Total Number of Pages, including this page: 12			
If you do not receive all of the pages, please call 314-552-6000 as soon as possible.			
Thank you, Fax Department - Operator:  Time of Transmission: 10:54 AM P.M.			
<small>Copyright Notice: The information contained in this facsimile transmission is legally privileged and confidential information intended only for the use of the individual or entity named herein. If you are not the named addressee, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this transmission in error, please notify the sender by return facsimile call and delete this transmission from your system. Thank you.</small>			
Received from 3145527000 at 4/3/03 11:54:05 AM Eastern Standard Time			

'03 APR 3 AM 11:11

** TX STATUS REPORT **

AS OF APR 03 2003 10:59 PAGE.01

THOMPSON COBURN

16 DATE TIME TO/FROM MODE MIN/SEC PGS JOB# STATUS 077
 04/03 10:57 USPTO EC-S 02'22" 012 138 OK

THOMPSON COBURN

Thompson Coburn LLP
 Attorneys at Law

One Mercantile Center
 St. Louis, Missouri 63101-1693
 314-552-6000
 FAX 314-552-7000
 www.thompsoncoburn.com

Facsimile

FOR IMMEDIATE DELIVERY

To	Firm Name	Phone	Fax
Examiner Ram Shukla	US PTO Group Art Unit 1632		703-872-9307

From: DANIEL KASTEN

Date: APRIL 3, 2003


Message:
 APPLICATION OF: WOLD
 SERIAL NO. 09/111,911
 FILED: JULY 8, 1998
 TITLE: INHIBITING APOPTOSIS WITH ADENOVIRUS RID PROTEIN
 EXAMINER: RAM R. SHUKLA, PH.D.
 GROUP ART UNIT 1632

Atty/Client/Matter No.: 3067/66153/05587

Total Number of Pages, including this page: 12

If you do not receive all of the pages, please call 314-552-6000 as soon as possible.

Thank you,

Fax Department - Operator: Time of Transmittal: 10:54  P.M.**Confidentiality Note**

The information contained in this facsimile transmission is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this transmission is not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this transmission is strictly prohibited. If you have received this transmission in error, please immediately notify us by collect telephone call and return the original transmission to us at the above address by U.S. mail. Thank you.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


St. Louis, Missouri

October 4, 2002

CERTIFICATE OF FACSIMILE

I hereby certify that this document is being transmitted to the
U.S. Patent and Trademark Office via facsimile to fax no.
(703) 872-9307 on October 4, 2002.

Daniel S. Kasten
Attorney for Applicant(s)
Registration No.: 45,363


Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305

In re application of:
Wold, William S.M.

Serial No.: 09/111,911

Filed: July 8, 1998

For: Inhibiting Apoptosis with Adenovirs RID Protein

Examiner Ram R. Shukla, Ph.D.

Group Art Unit 1632

PETITION FOR EXTENSION OF TIME

Sir:

Applicant hereby petitions the Patent Office for a 1 month extension of time to and including October 17, 2002 to respond to the Official Action in the above-identified application. Small entity status is asserted. Please charge the small entity fee of \$110.00 to Deposit Account 20-0823. A duplicate copy of this Petition is enclosed for that purpose.

DOCKETED

DEC 04 2002

Thompson Coburn LLP

It is believed that the fee is correct, but the Patent Office is hereby authorized to charge
any deficiencies or credit any overpayment to deposit Account 20-0823.

Respectfully submitted,



Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305


October 4, 2002


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

St. Louis, Missouri
October 4, 2002

CERTIFICATE OF FACSIMILE

I hereby certify that this document is being transmitted to the
U.S. Patent and Trademark Office via facsimile to fax no.
(703) 872-9307 on October 4, 2002


Daniel S. Kasten
Attorney for Applicant(s)
Registration No.: 45,363


Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Wold, William S.M.	Group No.:	1632
Serial No.:	09/111,911	Atty. Docket No.:	66153-5587
Filed:	July 8, 1998		
For:	Inhibiting Apoptosis with Adenovirus RID Protein	Examiner:	Ram R. Shukla, Ph.D.

Commissioner of Patents and Trademarks
Washington, DC 20231

AMENDMENT AND RESPONSE

HONORABLE SIR:

Responsive to the official communication of September 13, 2002, Applicant submits the following Amendments and Remarks.

It is not believed that extensions of time are required beyond those, which may otherwise be provided for in documents accompanying this Amendment. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account 20-0823.

Please amend the above-identified application as set forth below.

In The Claims:

Cancel claims 7, 10 and 13.

26. (Amended) [The method of claim 13] A method for decreasing the rejection of transplanted cells comprising contacting the cells ex vivo with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, (e) the adenovirus lacks at least one functional E1 gene and (f) the rejection is mediated by Fas receptor activity; wherein the

DOCKETED

DEC 04 2002

Thompson Coburn LLP

)

recombinant adenovirus vector consists of a polynucleotide having a sequence set forth
in SEQ ID NO:5; and wherein the transplanted cells are in a mouse.

REMARKS

Amendments to the Claims

Claims 7, 10 and 13 have been cancelled. Claim 26 has been rewritten in independent form, and now includes the limitations of base claim 10 and intervening claim 13.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



Daniel S. Kasten, Reg. #45363
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6305
Fax: 314-552-7305

Clean Copy of Claim 26

26. (Amended) A method for decreasing the rejection of transplanted cells comprising contacting the cells ex vivo with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, (e) the adenovirus lacks at least one functional E1 gene and (f) the rejection is mediated by Fas receptor activity; wherein the recombinant adenovirus vector consists of a polynucleotide having a sequence set forth in SEQ ID NO:5; and wherein the transplanted cells are in a mouse.

** TX STATUS REPORT **

AS OF JUN 03 2003 15:41 PAGE.01

32 DATE TIME TO/FROM MODE MIN/SEC PGS JOB# STATUS
 06/03 15:39 USPTO EC-S 02'01" 008 243 OK

THOMPSON COBURN*Thompson Coburn LLP
Attorneys at Law*

One US Bank Plaza
 St. Louis, Missouri 63101-1693
 314-552-6000
 FAX 314-552-7000
 www.thompsoncoburn.com

Facsimile
FOR IMMEDIATE DELIVERY

To	Firm Name	Phone	Fax
Examiner Ram Shukla	US PTO		703-746-3103

From: Wendy S. Grissom-Eisenbauer, Paralegal

Date: 06/03/2003

Message:

Atty/Client/Matter No.: 3060/66153/05587

Total Number of Pages, including this page: 8

If you do not receive all of the pages, please call 314-552-6363 as soon as possible.

Thank you,

Fax Department - Operator: AKSTime of Transmittal: 3:37 A.M./P.M.**Confidentiality Note**

The information contained in this facsimile transmission is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this transmission is not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this transmission is strictly prohibited. If you have received this transmission in error, please immediately notify us by collect telephone call and return the original transmission to us at the above address by U.S. mail. Thank you.

THOMPSON COBURN

Thompson Coburn LLP
Attorneys at Law

One US Bank Plaza

St. Louis, Missouri 63101-1693

314-552-6000

FAX 314-552-7000

www.thompsoncoburn.com

Facsimile

FOR IMMEDIATE DELIVERY

To	Firm Name	Phone	Fax
Examiner Ram Shukla	US PTO		703-746-3103

From: Wendy S. Grissom-Eisenhauer, Paralegal

Date: 06/03/2003

Message:

Atty/Client/Matter No.: 3060/66153/05587

Total Number of Pages, including this page: 8

If you do not receive all of the pages, please call 314-552-6363 as soon as possible.

Thank you,

Fax Department - Operator: AKS

Time of Transmittal: 3:37 A.M./P.M.

Confidentiality Note

The information contained in this facsimile transmission is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this transmission is not the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this transmission is strictly prohibited. If you have received this transmission in error, please immediately notify us by collect telephone call and return the original transmission to us at the above address by U.S. mail. Thank you.

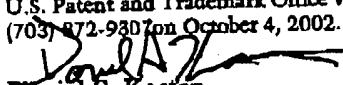
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

St. Louis, Missouri

October 4, 2002

CERTIFICATE OF FACSIMILE

I hereby certify that this document is being transmitted to the
U.S. Patent and Trademark Office via facsimile to fax no.
(703) 872-9307 on October 4, 2002.


Daniel S. Kasten

Attorney for Applicant(s)

Registration No.: 45,363


Daniel S. Kasten

Reg. No. 45363

Thompson Coburn LLP

#1 US Bank Plaza

St. Louis, MO 63101

314-552-6305

In re application of:
Wold, William S.M.

Serial No.: 09/111,911

Filed: July 8, 1998

For: Inhibiting Apoptosis with
Adenovirus RID Protein

:
:
:
: Examiner Ram R. Shukla, Ph.D.
:
:
:

: Group Art Unit 1632
:
:
:

PETITION FOR EXTENSION OF TIME

Sir:

Applicant hereby petitions the Patent Office for a 1 month extension of time to and including October 17, 2002 to respond to the Official Action in the above-identified application. Small entity status is asserted. Please charge the small entity fee of \$110.00 to Deposit Account 20-0823. A duplicate copy of this Petition is enclosed for that purpose.

DOCKETED

DEC 04 2002

Thompson Coburn LLP

It is believed that the fee is correct, but the Patent Office is hereby authorized to charge any deficiencies or credit any overpayment to deposit Account 20-0823.

Respectfully submitted,



Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305

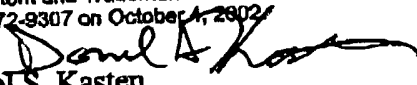
October 4, 2002


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

St. Louis, Missouri
October 4, 2002

CERTIFICATE OF FACSIMILE

I hereby certify that this document is being transmitted to the
U.S. Patent and Trademark Office via facsimile to fax no.
(703) 872-9307 on October 4, 2002.


Daniel S. Kasten
Attorney for Applicant(s)
Registration No.: 45,363


Daniel S. Kasten
Reg. No. 45363
Thompson Coburn LLP
#1 US Bank Plaza
St. Louis, MO 63101
314-552-6305

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Wold, William S.M.	Group No.:	1632
Serial No.:	09/111,911	Atty. Docket No.:	66153-5587
Filed:	July 8, 1998		
For:	Inhibiting Apoptosis with Adenovirus RID Protein	Examiner:	Ram R. Shukla, Ph.D.

Commissioner of Patents and Trademarks
Washington, DC 20231

AMENDMENT AND RESPONSE

HONORABLE SIR:

Responsive to the official communication of September 13, 2002, Applicant submits the following Amendments and Remarks.

It is not believed that extensions of time are required beyond those, which may otherwise be provided for in documents accompanying this Amendment. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account 20-0823.

Please amend the above-identified application as set forth below.

In The Claims:

Cancel claims 7, 10 and 13.

26. (Amended) [The method of claim 13] A method for decreasing the rejection of transplanted cells comprising contacting the cells ex vivo with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, (e) the adenovirus lacks at least one functional E1 gene and (f) the rejection is mediated by Fas receptor activity; wherein the

DOCKETED

DEC 04 2002

Thompson Coburn LLP

recombinant adenovirus vector consists of a polynucleotide having a sequence set forth
in SEQ ID NO:5; and wherein the transplanted cells are in a mouse.

REMARKS

Amendments to the Claims

Claims 7, 10 and 13 have been cancelled. Claim 26 has been rewritten in independent form, and now includes the limitations of base claim 10 and intervening claim 13.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



Daniel S. Kastan, Reg. #45363
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6305
Fax: 314-552-7305

Clean Copy of Claim 26

26. (Amended) A method for decreasing the rejection of transplanted cells comprising contacting the cells ex vivo with a recombinant adenovirus comprising a polynucleotide encoding a RID α -S polypeptide, a RID α -L polypeptide and a RID β polypeptide, as disclosed in SEQ ID NO:1, SEQ ID NO:2 and SEQ ID NO:4, wherein (a) the polynucleotide is operably linked to a cytomegalovirus ("CMV") promoter, (b) the adenovirus enters the cell and delivers the polynucleotide to the cell, (c) the RID α -S polypeptide, RID α -L polypeptide and RID β polypeptide are expressed in the cell in an amount sufficient to inhibit apoptosis of the cell, (d) the cell expresses Fas, DR3, TRAIL-R1, or TRAIL-R2, (e) the adenovirus lacks at least one functional E1 gene and (f) the rejection is mediated by Fas receptor activity; wherein the recombinant adenovirus vector consists of a polynucleotide having a sequence set forth in SEQ ID NO:5; and wherein the transplanted cells are in a mouse.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1430
Alexandria, Virginia 22313-1430
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/111,911	07/08/1998	WILLIAM S. M. WOLD	16153-5587	6287

21888 7590 09/04/2003
THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

SHUKLA, RAM R

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

SEP 08 2003

THOMPSON COBURN

Advisory Action

Application No.

09/111,911

Applicant(s)

WOLD, WILLIAM S. M.

Examiner

Ram R. Shukla

Art Unit

1632

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 04 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☒ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 4 and 23-25.

Claim(s) objected to: 26.

Claim(s) rejected: 7, 10 and 13.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☐ Other: _____

DOCKETED

SEP 08 2003

Thompson Coburn LLP

RECEIVED

SEP 08 2003

RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER

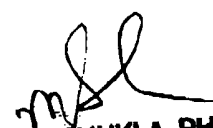
Ram R. Shukla, Ph.D.
 Primary Examiner
 Art Unit: 1632

Continuation Sheet (PTO-303)

Application No. 009/111,911

Continuation of 2. NOTE: Applicants have proposed to cancel claims 7, 10 and 13 and amend claim 26 by incorporating the limitations of claims 7, 10 and 13 in claim 26. However, as noted in the office action of 10-15-01, 1-2-02, 6-17-02 and 9-13-02, claimed invention is only enabled for an in vitro method of inhibiting apoptosis and not enabled for transplantation or therapy and since claim 26 as proposedly amended is directed to decreasing rejection of transplanted cells, it is not enabled for reasons of record. Additionally, applicants did not provide any explanation as to how the amendment reduced issues or addressed the rejection. Therefore, amendments to claim 26 do not reduce the issues for appeal because they do not address the grounds of enablement rejection set forth in the previous office actions. Applicants did not indicate what was the status of the new claims 27 and 28 proposed in the response of 8-21-02. Additionally, since applicants did not indicate what was to be done with the response filed 8-21-02, it is not clear what are the limitations of claim 26 as pending in view of the proposed amendments of 8-21-02 and 10-4-02. Therefore, amendments do not reduce the issues for appeal.

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' did not provide any new arguments with the proposed amendments as to how the proposed amendment to claim 26 addressed the enablement rejection set forth in the previous office actions of 10-15-01, 1-2-02, 6-17-02 and 9-13-02.



RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER